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First Named Inventor	Richard Elder
Art Unit	3625
Examiner Name	Garg, Yogesh

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Printed Name	George T. Marcou
Date	2\9\07
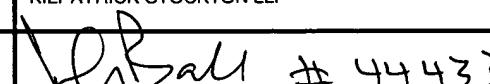
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. Application of:)

      RICHARD ELDER   )

Serial No.:   **09/610,540**   ) Art Unit: **3625**

Filed: **July 7, 2000**   ) Examiner: **Garg, Yogesh C.**

For: **METHOD AND SYSTEM FOR MANAGING AND CONDUCTING A NETWORK AUCTION**

AMENDED APPEAL BRIEF

Commissioner for Patents
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Randolph Building
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Sir:

This is an Amended Appeal Brief under 37 C.F.R. § 41.37 in connection with the Notice

of Non-Compliant Appeal Brief ("Notice") mailed on January 9, 2007 and the Final Office

action mailed on March 31, 2006. It is respectfully submitted that the topics required by Rule

41.37 is presented herewith and is labeled appropriately.

(1)   REAL PARTY IN INTEREST

The real party in interest in this appeal is the assignee of record, Citicorp Credit Services, Inc.

(2)   RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to be related to this case.

(3)   STATUS OF CLAIMS

Claims 16 and 18-21 are pending. Claims 18, 19, and 21 are allowed. Claims 16 and 20 are rejected and appealed. Claims 1-15, and 17 were previously cancelled.

(4)   STATUS OF AMENDMENTS

No amendments to the claims, specification or drawings were filed subsequent to final rejection.

(5)   SUMMARY OF CLAIMED SUBJECT MATTER

An embodiment of the present invention is a method for conducting an auction website operated by a sponsoring financial institution. (p. 7, lines 11-13). The embodiment comprises registering potential buyers and sellers for the auction website by verifying that the potential buyers and sellers have at least one active account with the sponsoring financial institution. (p. 8, line 11 – p. 9, line 7; Fig. 2, items S2, S12). Upon verification of at least one active account, issuing an individual registration identification to each of the potential buyers and sellers. (p. 9,

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lines 15-21; Fig. 2, items S10, S20). The individual registration identification is associated with the at least one active account. (p. 9, lines 16-21).

The method further includes facilitating access to the auction website through a network (p. 7, lines 13-17; Fig. 1, item 20); listing goods of registered sellers on the auction website; and accepting bids from registered potential buyers. (p. 9, line 22 – p. 10, line 5; Fig. 2, items S22, S24). Additionally, the method includes recognizing (i) a final bid amount for at least one good listed by a registered seller and (ii) a registered buyer who bids the final bid amount for the at least one good (p. 11, lines 16-22); prompting the registered buyer of the at least one good to select a buyer's payment account and the registered seller of the at least one good to select a seller's payment account. (p. 12, lines 1-4; Fig. 4, items S60, S62). Further, the method includes comparing the final bid amount to a pre-determined threshold amount to determine a preferred payment process (p. 12, lines 8-15).

The preferred payment process, when the final bid amount is above the pre-determined threshold amount, includes: debiting the buyer's selected payment account for the final bid amount; depositing the final bid amount into an escrow account; and facilitating settlement between the buyer payment account and the seller payment account both held at the sponsoring financial institution (p. 16, lines 11-16; Fig. 4, item S70).

The facilitation of the settlement between the buyer's payment account and the seller's payment account includes: setting a first time period within which the seller must deliver the good to the buyer; when the seller delivers the good to the buyer within the first time period, setting a second time period within which the buyer inspects the goods to determine conformance (p. 13, line 5 – p. 14, line 4; Fig. 5, item S80, S86, S88); and when either (i) the

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buyer acknowledges conformance of the good within the second time period or (ii) the second

time period expires with no further contact from the buyer, retrieving the final bid amount from

the escrow account; and then crediting the final bid amount to the seller's payment account (p.

17, lines 18 – 23; Fig. 6, items S120, S122, S124).

(6)   GROUNDS OF REJECTION PRESENTED FOR REVIEW

Claims 16 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over

U.S. Patent 6,260,024 to Shkedy in view of U.S. Patent 5,426,281 to Abecassis and further in

view of U.S. Patent Application 2001/0018665 to Sullivan *et al.*

(7)   ARGUMENT

Claims 16 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over

U.S. Patent 6,260,024 to Shkedy in view of U.S. Patent 5,426,281 to Abecassis and further in

view of U.S. Patent Application 2001/0018665 to Sullivan *et al.* ("Sullivan"). Pursuant to the

requirements for establishing a *prima facie* case of obviousness under 35 U.S.C. §103, all the

claim limitations must be taught or suggested by the prior art. *In re Royka,* 490 F.2d 981, 180

USPQ 580 (CCPA 1974). Referring to MPEP Section 2142,

> [t]o establish a *prima facie* case of obviousness, three basic criteria must be
> met. First, there must be some suggestion or motivation, either in the
> references themselves or in the knowledge generally available to one of
> ordinary skill in the art, to modify the reference or to combine reference
> teachings. Second, there must be a reasonable expectation of success. Finally,
> **the prior art reference (or references when combined) must teach or**
> **suggest all the claim limitations.** The teaching or suggestion to make the
> claimed combination and the reasonable expectation of success must both be

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found in the prior art, and not based on the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

(emphasis added). The Examiner fails to establish a *prima facie* case of obviousness. As admitted by the Examiner, "Shkedy in view of Abecassis does not disclose comparing the final bid amount to a predetermined threshold amount to determine a preferred payment process" as recited in claim 16 of the present application. *See* page 9 of the March 31, 2006 Office Action. The Examiner improperly attempts to rely on Sullivan for teaching this step. Specifically, the Examiner asserts that:

> However, in the same field of electronic commerce, Sullivan discloses comparing the final bid amount to a pre-determined threshold amount to determine a preferred payment process (see paragraph 0080, pg. 8, " *The database server 32 enables the account administrator to enter any special promotion payment terms, as indicated by block 300..... Special promotion payment terms can encompass anything particular to the individual promotion, ...These special promotion payment terms are also settled by the system 10. ...* " and paragraph 0097, pg. 11, "*The application 174 uses the terms of the promotion to calculate the amount of money due to or that the manufacture owes to the retailer for the promotion based upon the number of promoted products sold or the payment value contracted amount.*" Note: Sullivan explicitly discloses that promotions, such as special terms of payment are directly related to the contracted value, that is the final bid amount in the application and vary depending upon if the final bid amount in the application and vary depending upon if the final bid amount is more or equal or less than a threshold amount). In view of Sullivan, it would have obvious to one of ordinary skill in the art at the time of the applicant's invention to have modified Shkedy in view of Abecassis to incorporate the feature of comparing the final bid amount to a pre-determined threshold amount to determine a preferred payment process because such promotions of special payment terms are a part of variety of promotions that sellers/retailers use to sell their products/increase their revenues and profits. For, example, stores like Best Bu, Circuit City, etc. provide no interest payment terms for a determined period of time if the order value is more than a predetermined amount, such as a $1000, or whatsoever and these special terms of payment motivate buyers to buy large ticket items. If the total order value is less than $1000 then different payment terms are applicable.

Claim 16 of the present application recites the step of "comparing the <u>final bid amount</u> to a pre-determined threshold amount <u>to determine a preferred payment process</u>, wherein the preferred payment process when the final bid amount is above the pre-determined threshold amount includes: ..." (emphasis added). As recited in the specification of the present application "... once both the buyer and seller have selected their respective accounts/bills, there are at least two payment scenarios, the first is an immediate transferal of the payment from the buyer to seller, the second is a transferal of the payment into an escrow account where the money is only transferred to the seller upon the occurrence of certain events ... selecting an exemplary amount for illustration purposes, if the final bid price is less than or equal to $500, the first, immediate payment scenario occurs. If the final bid price is greater than $500, the second escrow payment scenario occurs." *See* p. 12, ll. 8-19. Therefore in claim 16, the final bid price is compared to a pre-determined threshold amount, e.g., $500, and if the final bid price is higher than the pre-determined threshold amount, then the escrow payment scenario is used. Thus, the pre-determined threshold amount is used to determine the payment process: whether to use an escrow payment process or not.

In contrast, Sullivan discloses a system and method for administering promotions which does not include a bid process. The cited paragraphs, paragraphs 0080 and 0097, disclose a payment system. Specifically, these paragraphs disclose an account administrator entering special promotion payment terms, e.g., special advertising fees, special display fees, etc. *See* para. 0080. "These special promotions payment terms are settled by the system 10." *Id.* Paragraph 0097 recites that:

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The application 174 uses the terms of the promotion to calculate the amount of money due to or that the manufacturer owes to the retailer for the promotion based upon the number of promoted products sold or the payment value contracted amount, the discounts given by the retailer to the customers, and the terms of the promotion. The independent system may use one of three options for facilitating settlement of the promotions. These options include: (1) electronic funds transfer (EFT) payments through an appropriate financial institution or system; (2) preparation of an invoice which the manufacturer pays by check (or other payment method); or (3) deduction of the retailer's payments to the manufacturer for products supplied by the manufacturer. The independent system 24 also calculates the fees the retailer and manufacturer owe to the independent system operator for administering the promotions and includes fees in the settlement.

Thus the special promotions payment terms are used to calculate the amount owed.

Paragraph 0097 discloses three different payment options, but does not teach or suggest that a pre-determined threshold amount dictates which option is used. Sullivan does not use a pre-determined threshold amount to determine the payment option. In addition, Sullivan does not use a final bid amount to determine the payment option but rather calculates a final amount owed. Determining the amount owed is not the same as comparing a final bid amount to a pre-determined threshold amount to determine the payment option. Thus, Sullivan does not teach or suggest "comparing the final bid amount to a pre-determined threshold amount to determine a preferred payment process, wherein the preferred payment process when the final bid amount is above the pre-determined threshold amount includes:..." as recited in claim 16 of the present application.

Moreover, the Examiner is not providing the proper suggestion or motivation for combining the cited art. The prior art must suggest the desirability of the claimed invention. Specifically, MPEP 2143.01 recites that:

"In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Since Sullivan does not teach or suggest comparing the final bid amount to a pre-determined threshold amount to determine if a preferred payment process, it cannot provide the proper suggestion or motivation for such a combination. The Examiner attempts to provide an example of a preferred payment process using a no interest payment promotion, however this example is one the Examiner conceived and did not derive from Sullivan.

Moreover, recognizing after the fact that such a modification would provide an improvement or advantage, *without suggestion thereof by the prior art*, rather than dictating a conclusion of obviousness, is an indication of improper application of hindsight considerations. Simplicity and hindsight are not proper criteria for resolving obviousness. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967). It is only the applicants' disclosure that discloses comparing a final bid amount to a pre-determined threshold amount to determine if a preferred payment process should be used. Thus, the only motivation of record for the proposed

modification is found in Applicant's disclosure which, of course, may not properly be relied upon to support the ultimate legal conclusion of obviousness under 35 U.S.C. §103. *Panduit Corp. v. Dennison Mfg. Co.,* 810 F.2d 1561, 227 1 USPQ2d 1593 (Fed. Cir. 1987). Thus, the Examiner is using hindsight which is not proper criteria for resolving obviousness.

Finally, the undersigned representative continues to respectfully disagree with the Examiner's assertion of Sullivan being analogous art. Regarding claim 20, as admitted by the Examiner, "its limitations are closely parallel to the limitation of claim 16 except ..." *See* page 10 of the March 31, 2006 Office Action. Similar to the arguments above, the cited art does not teach or suggest "comparing the final bid amount to a pre-determined threshold amount to determine a preferred payment process, wherein the preferred payment process when the final bid amount is below the pre-determined threshold amount includes: ..." as recited in claim 20 of the present application. In addition, the above arguments regarding claim 16 also apply to claim 20.

For at least these reasons, claims 16 and 20 are patentable over the cited art.

(8) **Claims Appendix**

See attached Claims Appendix

(9) **Evidence Appendix**

None

(10) **Related Appendix**

None.

Respectfully submitted,

BY: _____ # 44,433
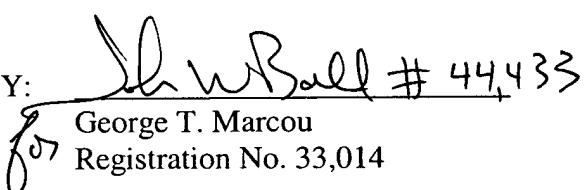
George T. Marcou
Registration No. 33,014

KILPATRICK STOCKTON LLP
Suite 900
607 14th Street, N.W.
Washington, D.C. 20005
(202) 508-5800 (phone)
(202) 508-5858 (fax)

(8)   CLAIMS APPENDIX

1. -15. (Previously Cancelled)

16. A method for conducting an auction website operated by a sponsoring financial institution comprising:

registering potential buyers and sellers for the auction website by verifying that the potential buyers and sellers have at least one active account with the sponsoring financial institution;

upon verification of at least one active account, issuing an individual registration identification to each of the potential buyers and sellers having at least one active account with the sponsoring financial institution, wherein the individual registration identification is associated with the at least one active account;

facilitating access to the auction website through a network;

listing goods of registered sellers on the auction website;

accepting bids from registered potential buyers for listed goods of registered sellers through the auction website;

recognizing (i) a final bid amount for at least one good listed by a registered seller and (ii) a registered buyer who bids the final bid amount for the at least one good;

prompting the registered buyer of the at least one good to select a buyer's payment account and the registered seller of the at least one good to select a seller's payment account;

comparing the final bid amount to a pre-determined threshold amount to determine a preferred payment process, wherein the preferred payment process when the final bid amount is above the pre-determined threshold amount includes:

debiting the buyer's selected payment account for the final bid amount; and

depositing the final bid amount into an escrow account; and

facilitating settlement between the buyer payment account and the seller payment account both held at the sponsoring financial institution, wherein facilitating settlement between the buyer's payment account and the seller's payment account includes:

setting a first time period within which the seller must deliver the good to the buyer;

when the seller delivers the good to the buyer within the first time period, setting a second time period within which the buyer inspects the goods to determine conformance; and

when either (i) the buyer acknowledges conformance of the good within the second time period or (ii) the second time period expires with no further contact from the buyer, retrieving the final bid amount from the escrow account; and

crediting the final bid amount to the seller's payment account.

17. (Previously Cancelled)

18. A method for conducting an auction website operated by a sponsoring financial institution comprising:

registering potential buyers and sellers for the auction website by verifying that the potential buyers and sellers have at least one active account with the sponsoring financial institution;

upon verification of at least one active account, issuing an individual registration identification to each of the potential buyers and sellers having at least one

active account with the sponsoring financial institution, wherein the individual registration identification is associated with the at least one active account;

facilitating access to the auction website through a network;

listing goods of registered sellers on the auction website;

accepting bids from registered potential buyers for listed goods of registered sellers through the auction website;

recognizing (i) a final bid amount for at least one good listed by a registered seller and (ii) a registered buyer who bids the final bid amount for the at least one good;

prompting the registered buyer of the at least one good to select a buyer's payment account and the registered seller of the at least one good to select a seller's payment account;

comparing the final bid amount to a pre-determined threshold amount to determine a preferred payment process, wherein the preferred payment process when the final bid amount is above the pre-determined threshold amount includes:

debiting the buyer's selected payment account for the final bid amount; and

depositing the final bid amount into an escrow account; and

facilitating settlement between the buyer payment account and the seller payment account both held at the sponsoring financial institution, wherein facilitating settlement between the buyer's payment account and the seller's payment account includes:

setting a first time period within which the seller must deliver the good to the buyer;

when the seller delivers the good to the buyer within the first time period, setting a second time period within which the buyer must inspect the goods to determine conformance;

when the buyer determines that the good is non-conforming, setting a third time period within which the buyer either (iii) returns the good to the seller or (iv) requests a bargaining session with the seller;

when the buyer returns the good to the seller within the third time period, setting a fourth time period within which the seller inspects the good to determine if the good is in the same condition as it was in when it was originally sent to the buyer; and

when the seller determines that the good is in the same condition, retrieving the final bid amount from the escrow account; and

returning the final bid amount to the buyer's payment account.

19. A method for conducting an auction website operated by a sponsoring financial institution comprising:

registering potential buyers and sellers for the auction website by verifying that the potential buyers and sellers have at least one active account with the sponsoring financial institution;

upon verification of at least one active account, issuing an individual registration identification to each of the potential buyers and sellers having at least one active account with the sponsoring financial institution, wherein the individual registration identification is associated with the at least one active account;

facilitating access to the auction website through a network;

listing goods of registered sellers on the auction website;

accepting bids from registered potential buyers for listed goods of registered sellers through the auction website;

recognizing (i) a final bid amount for at least one good listed by a registered seller and (ii) a registered buyer who bids the final bid amount for the at least one good;

prompting the registered buyer of the at least one good to select a buyer's payment account and the registered seller of the at least one good to select a seller's payment account;

comparing the final bid amount to a pre-determined threshold amount to determine a preferred payment process, wherein the preferred payment process when the final bid amount is above the pre-determined threshold amount includes:

debiting the buyer's selected payment account for the final bid amount; and

depositing the final bid amount into an escrow account; and

facilitating settlement between the buyer payment account and the seller payment account both held at the sponsoring financial institution, wherein facilitating settlement between the buyer's payment account and the seller's payment account includes:

setting a first time period within which the seller must deliver the good to the buyer;

setting a second time period within which the buyer must inspect the goods to determine conformance when the seller delivers the good to the buyer within the first time period;

setting a third time period within which the buyer either (iii) returns the good to the seller or (iv) requests a bargaining session with the seller when the buyer determines that the good is non-conforming;

setting a fourth time period within which the buyer and the seller negotiate a new bid price for the good when the buyer requests a bargaining session with the seller and the seller agrees to the bargaining session;

comparing the final bid price to the new bid price to determine a difference, when an identical new bid price is received from both the buyer and seller within the fourth time period;

retrieving the final bid price from the escrow account;

returning an amount equal to the difference to the buyer's payment account; and

crediting the seller's payment account with the new bid price.

20. A method for conducting an auction website operated by a sponsoring financial institution comprising:

registering potential buyers and sellers for the auction website by verifying that the potential buyers and sellers have at least one active account with the sponsoring financial institution;

upon verification of at least one active account, issuing an individual registration identification to each of the potential buyers and sellers having at least one active account with the sponsoring financial institution, wherein the individual registration identification is associated with the at least one active account;

facilitating access to the auction website through a network;

listing goods of registered sellers on the auction website;

accepting bids from registered potential buyers for listed goods of registered sellers through the auction website;

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recognizing (i) a final bid amount for at least one good listed by a registered seller and (ii) a registered buyer who bids the final bid amount for the at least one good;

prompting the registered buyer of the at least one good to select a buyer's payment account and the registered seller of the at least one good to select a seller's payment account;

comparing the final bid amount to a pre-determined threshold amount to determine a preferred payment process, wherein the preferred payment process when the final bid amount is below the pre-determined threshold amount includes:

debiting the buyer's selected payment account for the final bid amount and crediting the seller's selected payment account with the final bid amount; and

facilitating settlement between the buyer payment account and the seller payment account both held at the sponsoring financial institution, wherein facilitating settlement between the buyer's payment account and the seller's payment account includes:

setting a first time period within which the seller must deliver the good to the buyer;

when the buyer does not receive the good from the seller within the first time period, returning the final bid amount to the buyer's payment account and charging the seller's payment account with the final bid amount.

21. A method for conducting an auction website operated by a sponsoring financial institution comprising:

registering potential buyers and sellers for the auction website by verifying that the potential buyers and sellers have at least one active account with the sponsoring financial institution;

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upon verification of at least one active account, issuing an individual registration identification to each of the potential buyers and sellers having at least one active account with the sponsoring financial institution, wherein the individual registration identification is associated with the at least one active account;

facilitating access to the auction website through a network;

listing goods of registered sellers on the auction website;

accepting bids from registered potential buyers for listed goods of registered sellers through the auction website;

recognizing (i) a final bid amount for at least one good listed by a registered seller and (ii) a registered buyer who bids the final bid amount for the at least one good;

prompting the registered buyer of the at least one good to select a buyer's payment account and the registered seller of the at least one good to select a seller's payment account;

comparing the final bid amount to a pre-determined threshold amount to determine a preferred payment process, wherein the preferred payment process when the final bid amount is below the pre-determined threshold amount includes:

debiting the buyer's selected payment account for the final bid amount and crediting the seller's selected payment account with the final bid amount; and

facilitating settlement between the buyer payment account and the seller payment account both held at the sponsoring financial institution, wherein facilitating settlement between the buyer's payment account and the seller's payment account includes:

setting a first time period within which the seller must deliver the good to the buyer;

setting a second time period within which the buyer must inspect the goods to determine conformance when the seller delivers the good to the buyer within the first time period;

setting a third time period within which the buyer either (iii) returns the good to the seller or (iv) requests a bargaining session with the seller when the buyer determines that the good is non-conforming;

setting a fourth period within which the buyer and the seller negotiate a new bid price for the good when the buyer requests a bargaining session with the seller and the seller agrees to the bargaining session;

comparing the final bid amount to the new bid price to determine a difference when an identical new bid price is received from both the buyer and seller within the fourth period;

crediting an amount equal to the difference to the buyer's payment account; and

debiting the seller's payment account for an amount equal to the difference.

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